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EXAMINER

WOO, STELLA L

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2643

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/134,831
Filing Date: August 17, 1998
Appellant(s): METTKE, RICHARD P.

MAILED

AUG 17 2005

Technology Center 2600

Richard P. Mettke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 20, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because it references portions of U.S. Patent No. 5,602,905 which are not supported by the original disclosure. The portions which are not supported by the original disclosure include: col. 2, lines 3-7; col. 2, line 53 through col. 3, line 3; Figure 2.

(6) *Issues*

Appellant's brief presents arguments relating to whether new matter was introduced into the drawings and specification. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(7) *Grouping of Claims*

The rejection of claims 6-9 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Weiner, Allen. "TouchFax Provides the Ultimate in Place-Based Interactivity."
Interactive World (October 1992), pp. 48-49.

TouchFax Information Systems, Inc. "Vision, Power, Versatility" brochure, (1991).

Shah, Rawn. "Suggestions for Information Kiosk Systems using the World Wide Web."
<http://www.rtd.com/people/rawn/kiosk-paper.html> (April 30, 1994), pp. 1-5.

"The World Wide Web Conferences, 1994-1995, Kiosk Papers."
<http://www.visi.com/~keefner/pdfs/twwwc.htm>, see. pp. 1-3.

(10) *Grounds of Rejection*

(A) The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention for the same reasons given in the final Office action mailed March 12, 2002 and repeated below.

Claim 7, as amended in the paper filed December 11, 2001, recites “a keyboard which communicates with and controls a microprocessor” which is not supported by the original disclosure as filed on January 23, 1995. The original disclosure makes no mention of the keyboard controlling a microprocessor. Furthermore, there is no provision in the original disclosure for “a microprocessor” in addition to the “CPU” already recited in claim 6, from which claim 7 depends.

(B) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article by Allen Weiner, entitled “TouchFax Provides the Ultimate in Place-Based Interactivity” (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter “Exhibit E”) in view of the TouchFax brochure entitled “Vision, Power, Versatility” (submitted as Exhibit F in the TouchNet Protest on November 4, 1998, hereinafter “Exhibit F”), and further in view of an article by Rawn Shah entitled “Suggestions for Information Kiosk Systems using the World Wide Web”, submitted with the Protest by North Communications, Inc. as Exhibit I (hereinafter “the Shah article”) for the same reasons given in the final Office action mailed March 12, 2002 and repeated below.

Exhibit E discloses a public on-line, pay-as-you-use communications terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising:

a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

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a telephone access node (data port; Exhibit E, second page, first column, third paragraph, line 3);

an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11);

a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);
means for accessing and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph);

a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

Exhibit E differs from claim 6 in that it does not *explicitly* recite software installed into the CPU to allow interaction with credit card centers. However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the credit card centers in order to authorize payments made via the credit card reader.

The combination of Exhibits E and F differs from claim 6 in that it does not specify accessing and interfacing with the Internet. However, the combination does allow for accessing

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and interfacing with a remote service provider via a modem and the Shah article teaches the desirability of providing access to and interaction with the Internet in a kiosk-based information system (pages 1-2, section entitled "The Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to provide users with access to the many services on the Internet including a paid service by commercial organizations which charges customers for access to specific services (page 2, section entitled "Who will use these systems?" and page 5, lines 11-12). It would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information system, as taught by the Shah article, within the combination of Exhibits E and F in order to provide users with access to the many services available on the Internet.

Regarding claim 7, Exhibit E provides for a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5).

Regarding claim 8, Exhibit E provides for printing a detailed receipt (Exhibit E, second page, first column, second paragraph) or any other document retrieved from a remote source (Exhibit E, second page, second column, second paragraph, lines 9-13).

Regarding claim 9, as described above with regard to claim 6, Exhibit E provides for a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3), a monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph), a credit card reader swipe device (Exhibit E, second page, first column, second paragraph, lines 4-6), an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second

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paragraph, line 11), and a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

(11) Response to Argument

(A) Regarding the rejection of claim 7 under 35 USC 112, first paragraph, Appellant argues that “[a]s far as keyboards communication with a microprocessor, it is well established in prior art that that is what a keyboard does (communicates with a CPU’s microprocessor).” However, claim 7 recites “a keyboard which communicates with and controls a microprocessor” [emphasis added]. The original disclosure fails to describe the keyboard controlling the microprocessor. Communication and control are two distinct functions. Further, Appellant cannot rely on citations of other U.S. patent to provide support for subject matter missing from Appellant’s own written description.

(B) Regarding the rejection of claims 6-9 under 35 USC 103(a), Appellant argues that “Exhibit E is not proper prior art.” However, Exhibit E is an article from a magazine titled Interactive World, which is clearly a printed publication with a publication date of October 1992. Appellant points to MPEP 2128.01 as requiring a level of accessibility. Any published magazine, such as Interactive World, can be considered as sufficiently accessible to the public. MPEP 2128.02 states that “a magazine or technical journal is effective as of its date of publication.” Additionally, MPEP 901.06 states that “[a]ll printed publications may be used as references, the date to be cited being the publication date.”

Appellant further argues that “Exhibit E fails to disclose, teach, or suggest linking the facsimile kiosk of Exhibit E with Internet.” However, the Shah article was relied upon for its teaching of Internet access via a kiosk. Appellant similarly argues that the TouchFax Brochure

(Exhibit F) “does not mention connectivity to the Internet.” Again, the Shah article was relied upon for its teaching of Internet access in a kiosk environment.

Appellant argues that “[t]he words ‘means for accessing commercial on-line services’ has apparently been inserted by the ‘examiner’.” However, the above-described phrase does not appear anywhere in the rejection.

Appellant argues that “Exhibit F is not proper prior art.” However, Exhibit F is one of a series of product brochures which were distributed to the public without restriction, Exhibit F being available to the public in March/April of 1991 (see pages 54-56 of the Deposition of Daniel J. Toughey, Litigation captioned Richard P. Mettke v. Touchnet Information Systems, Inc., Civ. Action No. 98-PT-0596 in the United States District Court for the Northern District of Alabama, submitted by Appellant on August 17, 1998).

Appellant further argues that “Exhibit F fails to disclose, teach or suggest software installed into the CPU to allow interface with the internet and credit card service centers.” However, the second paragraph of the first page describes the TF700 as “a powerful hardware/software system engineered to provide a comprehensive set of communication functions. TouchNet network management software collects usage and billing data...” The second page shows the TF700 as having a credit card reader, allowing payment by major credit cards. Regarding connection with the Internet, the Shah article was relied upon for its teaching of Internet access in a kiosk environment.

Appellant argues that “the Shah Article is also not proper prior art” and “was only located on the World Wide Web.” MPEP 2128 states that “[a]n electronic publication, including an on-line database or Internet publication, is considered to be a ‘printed publication’ within the

meaning of 35 USC 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates.” The Shah article is clearly accessible over the Internet to any person concerned with kiosks. Appellant further argues that “the article is dated 30 April 1994, but there is no mention of when it was posted on the WWW or the distribution of the article.” However, this article by Shah was published at the first International WWW Conference which took place May 25-27, 1994 (see paper entitled “The World Wide Web Conferences 1994-1995 Kiosk Papers; <http://www.visi.com/~keefner/pdfs/twwwc.htm>) such that the 30 April 1994 date is consistent with its submission for a conference dated May 25-27, 1994.

Appellant further argues that “[t]here is no discussion anywhere in the Shah Article regarding how a user of the kiosks in the Shah Article would pay for the use of the kiosks.” However, Exhibit E already provides for a credit card reader (second page, first column, second paragraph, lines 4-6) to allow payment for services provided by the terminal.

Appellant argues that “[n]one of the references discloses or suggests charging users for terminal access.” However, claims 6-9 do not recite charging for terminal access. Claim 6, lines 8-9 recite “a credit card reader swipe device...for accepting payment by a user for use of the terminal” [emphasis added]. Exhibit E clearly teaches a credit card reader which accepts payment by a user for use of the terminal to carry out various services, e.g. facsimile communication, word processing, high-quality copying, fax mailbox service, electronic library access (first page, fifth paragraph; second page, first column, second and fourth paragraphs; second page, second column, first and second paragraphs) such that the combination of Exhibits E, F and Shah would result in the use of the credit card reader swipe device to pay for the ability to retrieve information from the Internet.

Regarding Appellant's provision of a statement from Mr. Greg Adank as appendix E, the statement is not in declaration or affidavit form and, therefore, not considered. According to MPEP 716.02(g), "The reason for requiring evidence in declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 USC 25 and 18 USC 1001."

Appellant argues that his invention provides an unexpected result but fails to provide any evidence or facts to support this argument.

In response to applicant's general argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Exhibit E teaches a credit card reader in a TouchFax terminal (second page, first column, second paragraph, lines 4-6) but differs from claim 6 in that it does not *explicitly* recite software installed into the CPU to allow interaction with credit card centers. However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the credit card centers in order to authorize payments made via the credit card reader. The combination of Exhibits E and F differs from claim 6 in that it does not specify accessing and

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interfacing with the Internet. However, the combination does allow for accessing and interfacing with a remote service provider via a modem and the Shah article teaches the desirability of providing access to and interaction with the Internet in a kiosk-based information system (pages 1-2, section entitled "The Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to provide users with access to the many services on the Internet including a paid service by commercial organizations which charges customers for access to specific services (page 2, section entitled "Who will use these systems?" and page 5, lines 11-12). It would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information system, as taught by the Shah article, within the combination of Exhibits E and F in order to provide users with access to the many services available on the Internet. In this way, the user is not limited to retrieving information from only one remote service provider.

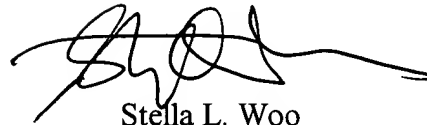
In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



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SW
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